



22852

PATENT TRADEMARK OFFICE

*7/Election
w/traverse*

PATENT

Attorney Docket No. 05725.0637

Application No. 09/820,954

TECH CENTER 1600/2900

MAR 18 2002

RECEIVED

bet
3-23-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL et al.

Group Art Unit: 1617

Application No.: 09/820,954

Examiner: M. Willis

Filed: March 30, 2001

For: COMPOSITIONS COMPRISING
AT LEAST ONE AMINATED C₅-
C₇ SACCHARIDE UNIT, AND
THEIR USE FOR THE
PROTECTION AND/OR REPAIR
OF KERATINOUS FIBERS

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS**A. Restriction Requirement**

In the Office Action mailed February 8, 2002, the Examiner has required
restriction between the following groups of claims:

Group I: Claims 1-36, drawn to a method for protecting keratinous fiber
comprising applying a composition comprising at least one compound
comprising at least one C₅-C₇ saccharide unit substituted with at least
one amino group, classified in class 424, subclass 401; and

Group II: Claims 37-72, drawn to a composition comprising at least one
compound comprising at least one C₅-C₇ saccharide unit substituted
with at least one amino group, and a kit containing the same,
classified in class 424, subclass 401.

The restriction requirement, as set forth above and on pages 2-3 of the Office
Action, is respectfully traversed. However, to be fully responsive to the restriction

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

BEST AVAILABLE COPY

requirement, Applicants elect, with traverse, the subject matter of Group II, claims 37-72.

The Examiner states that "the product can be used in a materially different process of using that product." See page 2 of the present Office Action. The Examiner states that it is his position "that a search for compositions comprised of glucosamine with the limitation of methods of protecting at least one keratinous fiber from extrinsic damage or repairing a keratinous fiber following extrinsic damage would not yield references disclosing compositions comprising the claimed compounds such as the Williams reference." See page 3 of the present Office Action.

First, Applicants respectfully point out that both groups of claims recite the limitation "for protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage." Accordingly, a proper search for either Group I or II may not yield references disclosing "the use of glucosamine for assisting in the healing of joint and connective disease damage...and methods of increasing the uptake of glucosamine in the body." See pages 2-3 of the present Office Action discussing Williams (U.S. Patent No. 5,679,344).

Second, the Examiner claims that "there is a serious burden on the examiner to examine both inventions" for the reason discussed above, set forth on page 3 of the present Office Action. Applicants refer Examiners to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden, but merely stated that it would be. However, according to the present Office Action, Groups I and II are all classified in the identical class and subclass - class 424, subclass 401. Accordingly, a search for these groups of claims will substantially, if not completely, overlap. Thus, for at least the foregoing reasons, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

B. Election of Species Requirement

The Examiner has also required an election of (a) a single disclosed species of the at least one compound comprising at least one C₅-C₇ saccharide unit substituted with at least one amino group and (b) a single disclosed species of the at least one additional sugar. Applicants traverse these election of species requirements on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the alleged species. In fact, the Examiner has failed to show that any burden exists. See pages 3-4 of the present Office Action.

However, to be fully responsive to the election of species requirement, Applicants elect with traverse, (a) glucosamine as at least one compound comprising at least one C₅-C₇ saccharide unit substituted with at least one amino group and (b) xylose as at least one additional sugar. Glucosamine is disclosed, for example, at page 18, line 20, page 19, line 3, in Examples 2-4, and reads on claims 37-39, 41, 43, 47-49, 58, 60-72 of

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Group II. Xylose is disclosed, for example, at page 19, line 20, and reads on claims 37-63, and 66-72 of Group II.


As discussed above, Applicants traverse the election of species requirement on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the claimed species. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined in this application. If the Examiner chooses to maintain the election requirement, however, and the elected species is found to be allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to the non-elected species, as is the duty of the Examiner according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (202) 408-4173.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 
Reg. No. 41,469
Anthony C. Tridico
Reg. No. 45,958

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Date: March 12, 2002